REMARKS

This response is a full and complete response to the non-final Office Action mailed April 23, 2007. In the present Office Action, the Examiner has noted that claims 1-7 are pending, that claims 4 and 7 stand rejected under 35 U.S.C. §112; and that claims 1-7 stand rejected under 35 U.S.C. §103.

By this response, reconsideration of the present application is respectfully requested. Claims 1-11 are now pending. Claims 1-7 are amended to correct minor and inadvertent typographical errors and to broaden the claims in various respects. Because the claims are not narrowed, there is no prosecution history estoppel. Likewise, no claims have been canceled and claims 8-11 have been added. Support for new claims 8-11 may be found throughout the specification and drawing figures.

Likewise, minor typographical errors in the specification and the abstract are corrected by the foregoing amendment. Again, the minor corrections do not alter claim scope and, therefore, do not result in prosecution history estoppel.

A replacement sheet for Figure 1 has also been submitted with this amendment. The application from which priority is taken does not state "prior art" on Figure 1. Figure 1, as filed, was incorrectly labeled as prior art. In addition, see, pages 4 and 5 of the specification. This has, therefore, been corrected and a new Figure 1 is submitted.

Please note we have made a change to the Brief Description of the Drawings by removing one or more erroneous descriptions of the drawings of the figures.

Applied Patents

The Action cites U.S. Patent 4,996,603 to Kanemitsu et al. ("Kanemitsu"); U.S. Patent 6,556,711 B2 to Koga et al. ("Koga"); and U.S. Patent 5,987,221 to Bearss et al. ("Bearss").

Claims Rejections under 35 U.S.C. §112

Claims 4 and 7 stand rejected under 35 U.S.C. §112, second paragraph. Without conceding that the Examiner is correct, in view of the amendment to these

claims, it is submitted that claims 4 and 7 are definite and allowable under 35 U.S.C. §112. It is respectfully requested that this rejection be withdrawn. Again, no prosecution history estoppel results because the claims have not been narrowed and may have, in fact, been broadened.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 1-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Kanemitsu, Koga, and Bearss. This rejection of these claims is respectfully traversed.

The Examiner is reminded that to successfully make a prima facie rejection under 35 U.S.C. § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill at the time the invention was made. KSR International, Co. v. Teleflex, Inc. (US 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill. See USPTO Memo entitled "Supreme Court decision on KSR Int'l. Co., v. Teleflex, Inc." (May 3, 2007). One way in which an Examiner may establish a prima facie case of unpatentability under 35 U.S.C. § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, teach or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the document(s) or to combine document teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success may both be found in the prior art, and should not be based on Assignee's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142 and § 2143 - 2143.03 for decisions pertinent to each of these criteria. It is respectfully asserted that the

Examiner has not met these standards. For example, the applied patents do not teach or suggest all the limitations of the aforementioned claims.

We begin with claim 1. The claim recites, for example, "combining said processed photo and processed character as a whole." This aspect of claim 1 is believed to not be shown or described in any of the applied patents, whether the patents are viewed individually or in combination. Specifically, the Examiner concedes at the bottom of page 3 and at the top of page 4 of the above referenced office action that this aspect is absent from Koga; however, the Examiner relies on Kanemitsu to cure the deficiencies of Koga. Nonetheless, a review of Kanemitsu makes apparent that it does not show or describe at least this aspect of claim 1. Rather, Kanemitsu addresses a selection between fixed slice processing and halftone processing so that the selected output may be provided, rather than combining the outputs. See, for example, column 4, lines 20-39; and Figure 4. Specifically, Kanemitsu, at line 24 of column 4, while expressly referring to Figure 4, discusses "a selection circuit" for the purpose just described. Therefore, the Examiner's position regarding the subject matter disclosed by Kanemitsu is not believed to be correct.

As a result, claim 1 is believed to patentably distinguish from the applied patents for at least the reasons discussed above. The remaining claims, which depend from claim 1, likewise patentably distinguish from the applied patents. It is noted that the Examiner also applies Bearss to reject claims 4 and 7; however, Bearss also fails to cure the deficiency discussed above. Therefore, claims 4 and 7 patentably distinguish from the three applied patents, whether viewed individually or in combination. It is, therefore, respectfully requested that the rejection of claims 1-7 be withdrawn and these claims be permitted to proceed to issuance.

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons. For example, Assignee specifically does not concede that the proposed combinations made by the Examiner are proper; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections

discussed above and it is, therefore, not believed to be necessary to discuss additional reasons for distinguishing the applied documents at this time. Nonetheless, Assignee reserves the right to raise these issues at a later time, if desired.

Further, it is noted that Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the Office Action does not indicate agreement or acquiescence with those asserted positions. Instead, the Examiner's positions are believed to be moot in light of the foregoing. Thus, similar to the point stated above, it is not believed to be necessary to comment upon every position taken by the Examiner with which Assignee does not agree.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Howard A. Skaist, Esq. at (503) 439-6500 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

In the event there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3703.

Respectfully submitted,

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By _____
Steve Munson, Patent Attorney
Registration No. 47,812

Customer No. 43831
Berkeley Law and Technology Group, LLP
17933 NW Evergreen Parkway, Suite 250
Beaverton, OR 97006
Phone: 503.439.6500

cc: Docketing